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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91221349
Party	Defendant Fireside Cider Co. LLC
Correspondence Address	BARBARA J LIPSHUTZ JACOBS & BURLEIGH LLP 445 PARK AVE FL 17 NEW YORK, NY 10022-2606 UNITED STATES bjl@jacobsburleigh.com, office@jacobsburleigh.com, bjlipshutz@yahoo.com
Submission	Other Motions/Papers
Filer's Name	Barbara J. Lipshutz
Filer's e-mail	bjl@jacobsburleigh.com
Signature	/Barbara J. Lipshutz/
Date	12/02/2015
Attachments	Amendment to Submit to TTAB.pdf(2456755 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matters of:

Trademark Application Serial No. 86/391,825  
Filed: September 11, 2014  
For the Mark WAYSIDE  
Published in the Official Gazette: February 3, 2015

-and-

Trademark Application Serial No. 86/400,459  
Filed: September 19, 2014  
For the Mark WAYSIDE  
Published in the Official Gazette: February 3, 2015

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TURN KEY WINE BRANDS LLC,	:	
Opposer,	:	
vs.	:	Opposition No. 91221349
	:	
FIRESIDE CIDER CO., LLC,	:	
Applicant.	:	
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**REQUEST TO AMEND APPLICATION**

Pursuant to 37 C.F.R. § 2.133 and TBMP § 514.01-02, Applicant Fireside Cider Co. LLC (“Applicant”), hereby requests amendment of Trademark Application Ser. No. 86/400,459, which is the subject of this Opposition, to modify the on consent of Opposer, which consent has been granted, the goods and services to read as follows:

Alcoholic beverages containing fruit, except beers and wines; Alcoholic carbonated Beverages, except beer and wines; Hard cider

The request to amend the description of goods and services is attached hereto. Opposer has indicated its consent to amend the application, as indicated in the attached Consent Agreement.

The parties have further agreed to seek the suspension of the Opposition proceeding,  
pending further examination of the respective trademark applications.

Dated: New York, New York  
December 2, 2015

JACOBS & BURLEIGH LLP  
Attorneys for Applicant

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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TURN KEY WINE BRANDS LLC,	:	
Opposer,	:	
vs.	:	Opposition No. 91221349
FIRESIDE CIDER CO., LLC,	:	
Applicant.	:	
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Applicant Fireside Cider Co. LLC hereby requests, on consent of the Opposer, which consent has been granted, to amend the description of goods and service of Trademark Application Ser. No. 86/400,459, to read as follows:

Alcoholic beverages containing fruit, except beers and wines; Alcoholic carbonated Beverages, except beer and wines; Hard cider

## CONSENT AGREEMENT

**THIS CONSENT AGREEMENT** (the “Agreement”), effective as of the last date of execution below (the “Effective Date”), is made by and between Turn Key Wine Brands LLC, a California limited liability company, with a business address of 132 East Carrillo Street, Santa Barbara, California 93101 (“Turn Key”), and Fireside Cider Co. LLC, a New York limited liability company, with a business address of 865 Webster Brook Road Spur, Delhi, New York 13753 (“Fireside”).

### RECITALS

A. Turn Key uses the mark WAYSIDE (the “Turn Key Mark”) in connection with various wines. Turn Key primarily sells its goods marketed under the Turn Key Mark to consumers via the internet, but intends to sell such goods now and in the future directly, through the internet and through distributors. Turn Key owns the U.S. application for trademark registration of the Turn Key Mark in International Class 33, having U.S. Serial No. 86,472,811 (for “Wines”) (the “Turn Key Application”).

B. Fireside uses the mark WAYSIDE (the “Fireside Mark”) in connection with hard cider, and intends to use the Fireside Mark in connection with alcoholic beverages containing fruit other than grapes, alcoholic beverages except beers and wines, alcoholic beverages of fruit other than grapes, and alcoholic carbonated beverages, except beers and wines. Fireside owns the U.S. applications for trademark registration of the Fireside Mark in International Class 33, having U.S. Serial Nos. 86,391,825 (for “Hard cider”) and 86,400,459 (*presently*, for “Alcoholic beverages containing fruit; Alcoholic beverages except beers; Alcoholic beverages of fruit; Alcoholic carbonated beverages, except beer; Hard cider”) (the “Fireside Applications”).

C. Turn Key has initiated an opposition proceeding in the Trademark Trial and Appeal Board against the Fireside Applications (“the TTAB Proceeding”).

D. Fireside has agreed to seek to amend the identification of goods within the Fireside Application bearing U.S. Serial No. 86,400,459 to the following:

“Alcoholic beverages containing fruit, except beers and wines; Alcoholic carbonated beverages, except beers and wines; Hard cider”

E. The parties have agreed jointly to seek the suspension of the TTAB Proceeding pending further *ex parte* examination of the Turn Key Application and the Fireside Application bearing U.S. Serial No. 86,400,459.

F. The parties, having considered their commercial interests as business persons and users of valuable marks, mutually believe that there is no likelihood of confusion which may arise out of the concurrent use by Fireside of the Fireside Mark for hard cider, alcoholic beverages containing fruit, except beers and wines; alcoholic carbonated beverages, except beers and wines; and by Turn Key of the Turn Key Mark for wines ; and

G. The parties would like to avoid public confusion and desire to establish a basis for cooperating and resolving any possible problems relating to their respective uses of the Fireside Mark and Turn Key Mark (collectively, the “Marks”) upon the terms and conditions set forth below.

### AGREEMENT

**NOW THEREFORE**, in consideration of the foregoing, and the mutual undertaking set forth herein, the parties agree as follows:

2. The parties agree there is no likelihood of confusion between the Marks because:
  - a. the Marks are used by their respective owners in connection with distinct and unrelated goods, in that the Fireside Mark is used in commerce in connection with hard cider and will be

used in commerce in connection with alcoholic beverages containing fruit, except beers and wines, and the Turn Key Mark is used in commerce in connection with wines; and

b. the Marks are used by their respective owners in connection with goods that are sold through distinct and different trade channels, in that the goods sold in connection with the Fireside Mark are primarily sold in restaurants, bars, and liquor stores, and the goods that are sold in connection with the Turn Key Mark are sold primarily through the internet; and

c. the goods sold in connection with the respective marks are fundamentally different, in that the goods sold in connection with the Fireside Mark are fruit-based alcoholic beverages other than wine and beer, and the goods sold in connection with the Turn Key Mark are wines ; and

d. the parties have agreed to adopt measures and to take precautions designed to avoid confusion in the marketplace between their goods branded with the respective Fireside Mark and Turn Key Mark, including those precautions and measures specified within paragraph 3.

3. The parties agree to take reasonable measures and precautions to avoid confusion in the marketplace between their respective goods branded with the respective Fireside Mark and Turn Key Mark. Additionally, should either party become aware of any instances of actual confusion, such party shall notify the other party and undertake reasonable measures to clarify and correct any mistaken impression, such as, but without limitation, directing confused third parties to the correct party. The parties agree to cooperate and consult with one another, in good faith, should future conditions or developments suggest to either party that the parties' respective marks might be likely to be confused with one another, all with the view to ensuring that no substantial confusion between the parties' respective marks, as they are used in commerce, shall occur. If any confusion or other dispute arises as a result of the use and/or registration of their respective Fireside Mark or Turn Key Mark despite their respective efforts to avoid confusion, the parties shall use good faith efforts in negotiations to resolve the dispute in good faith.

4. Fireside agrees that it will not oppose, seek to cancel, or otherwise interfere with Turn Key in obtaining and maintaining trademark registration of the Turn Key Mark in connection with "Wines". Likewise, Turn Key agrees that it will not oppose, seek to cancel, or otherwise interfere with Fireside in obtaining and maintaining trademark registration of the Fireside Mark in connection with "Hard cider" or in connection with "Alcoholic beverages containing fruit, except beers and wines; Alcoholic carbonated beverages, except beers and wines; Hard cider".

5. Should Fireside abandon the Fireside Mark, or should Turn Key abandon the Turn Key Mark, such party's rights under this Agreement shall terminate and the other party may thereafter use the abandoned mark, or any mark similar to the abandoned mark, unrestrained by the terms of this Agreement, and may thereafter apply for and obtain registration of the abandoned mark, or any mark similar to the abandoned mark, unrestricted by this Agreement.

a. For the purpose of this paragraph 5, with respect to the Fireside Mark, "abandon" shall mean failure to make first use of the Fireside Mark in-commerce in connection with hard cider within thirty (30) months of the Effective Date of this Agreement, or after Fireside makes its first use in-commerce of the Fireside Mark, non-use of the Fireside Mark in-commerce for three (3) consecutive years, or an affirmative intent by Fireside to abandon use of the mark.

b. For the purpose of this paragraph 5, with respect to the Turn Key Mark, "abandon" shall mean non-use of the Turn Key Mark in-commerce for three (3) consecutive years, or an affirmative intent by Turn Key to abandon use of the Turn Key Mark.

*(Signatures follow)*

IN WITNESS WHEREOF, each of the parties has caused this Consent Agreement to be executed by its duly authorized representative as of the date set forth below.

**Fireside**

**FIRESIDE CIDER CO. LLC**

By: \_\_\_\_\_  
Alex Wilson

Its: \_\_\_\_\_

Dated: \_\_\_\_\_

Executed at Delhi, New York.

**Turn Key**

**TURN KEY WINE BRANDS LLC**

By: Marshall Miller  
Marshall Miller

Its: Vice President

Dated: 10/6/15

Executed at Santa Barbara, California

IN WITNESS WHEREOF, each of the parties has caused this Consent Agreement to be executed by its duly authorized representative as of the date set forth below.

**Fireside**

**FIRESIDE CIDER CO. LLC**

By:  \_\_\_\_\_  
Alex Wilson

Its: Owner

Dated: 10/7/15

Executed at Delhi, New York.

**Turn Key**

**TURN KEY WINE BRANDS LLC**

By: \_\_\_\_\_  
Marshall Miller

Its: Vice President

Dated: \_\_\_\_\_

Executed at Santa Barbara, California